

al. ("Bauman") and further in view of U.S. Patent Pub. No. 2003/088537 to Ko. This rejection is respectfully traversed.

The Office Action acknowledges that the primary reference Wigren does not disclose all of the features of independent claim 1. Rather, the Office Action asserts that Bauman and Ko disclose the remaining features, and asserts that it would be obvious to combine the references. As justification that the combination is obvious, the Office Action asserts Wigren and Bauman are from the same field of endeavor. The Office Action provides no justification for why it would be obvious to combine Ko. Applicant respectfully asserts it would not be obvious to combine the applied references.

As discussed during the telephone interview, Wigren and Bauman art not from the "same field of endeavor." Wigren relates to the communication of geographic information relating to cell phones. More specifically, Wigren discloses a method for minimizing the amount of data that needs to be transmitted back and forth from cell towers to the cell phone, while still enabling the cell phone to know its elevation.

By contrast, Bauman related to methods for facilitating parallel processing between connected computers. See col. 1, lines 21-27 of Bauman. More specifically, Bauman relates to facilitating the transfer of data between multiple processors each processing a portion of a complex problem. Parallel computing is well understood in the art, and typically consists of several processors connected by either a common bus (such as a series of blade servers), or a local area network (in which multiple stand alone computers are linked so that the processor of each can tackle part of a larger problem. See col. 1, lines 48-49. This is substantially different from a cell phone network. As such, Bauman and Wigren are not related to the same field of endeavor.

During the telephone interview, the Examiner noted that the claims did not explicitly recite that the claimed method was related to cell phone technology, like Wigren. However,

as discussed during the telephone interview, the scope of the claims is irrelevant when determining whether Wigren and Bauman are from the same field of endeavor. The question of whether Wigren and Bauman are analogous art to the claims is a separate inquiry.

In this case, Wigren is from the cell phone field and Bauman is not. Thus, the references are not from the same field of endeavor as asserted by the Office Action. As such, the Office Action has provided no justification why one of ordinary skill in the art would have thought it obvious to combine the references.

With regard to the combination of Wigren with Ko, the Office Action states it would be obvious to combine Ko with Wigren and Bauman, but provides no further justification or evidence to support its assertion. This is insufficient to support a rejection. MPEP §2143 articulates that an Office Action must lay out a prima facie reason why one of ordinary skill in the art would have desired to combine the applied references.

For example, the MPEP states that such reasons may be that it would be obvious to try the combination because the prior art demonstrates that (1) "at the time of the invention there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem; (2) that there were "a finite number of identified, predictable potential solutions to the recognized need or problem" and (3) that one of ordinary skill in the art could have pursued those potential solutions "with a reasonable expectation of success." See MPEP §2143(E), elements (2) and (3) of the "Obvious to Try" standard.

However, in the absence of any rationale for combining Ko with Wigren, the Office Action has failed to present a prima facie rejection.¹ Therefore, withdrawal of the rejection of claims 1 and 3 is respectfully requested.

¹ Applicant also states for the record that Ko is not from the same field of endeavor as Wigren. Ko relates to determining the geographic locations of cell phones while Ko relates to data compression.

Claim 21 is rejected under 35 U.S.C. 103(a) over Couronne in view of Bauman and further in view of Ko. This rejection is respectfully traversed.

The Office Action asserts that the combination of Couronne, Bauman and Ko discloses all the recited elements of claim 21. However, as discussed during the December 30 interview, Couronne, Bauman and Ko are from disparate technical fields.

Couronne discloses a system for determining the position of an object using a plurality of transmitting and receiving devices. As discussed above, Bauman relates to parallel computing, while Ko relates to data compression. These references are in highly disparate fields. The Office Action provides no explanation why one of ordinary skill would have thought there would be a benefit to combining the applied references, or that the references could even be successfully combined. Thus, it would not have been obvious to one of ordinary skill in the art, to try and combine the features of these references. Therefore, withdrawal of the rejection of claim 21 is respectfully requested.

Claims 2 and 4-8 are rejected under 35 U.S.C. 103(a) over Wigren, Bauman and Ko, and further in view of U.S. Patent Pub. No. 2006/0135186 to Hans et al. ("Hans").

Claims 9-16 are rejected under 35 U.S.C. 103(a) over Wigren, Bauman and Ko further in view of U.S. Patent No. 7,039,421 to Couronne et al. ("Couronne"). Claims 17-19 are rejected under 35 U.S.C. 103(a) over Wigren, Bauman, Ko, Couronne and Hans. These rejections are respectfully traversed.

Claims 2 and 4-19 are all rejected using assorted combinations of Wigren, Bauman, Ko and Couronne. For the reasons articulated above, it would not have been obvious to one of ordinary skill in the art to combine these references.

Additionally, Claims 2 and 4-19 depend from claim 1. Thus, claims 2 and 4-19 also are in condition for allowance based on their dependence from claim 1, as well as for the separately patentable subject matter they recite.

Accordingly, withdrawal of the rejections of claims 2 and 4-19 is respectfully requested.

Furthermore, should the Examiner seek to maintain the current rejection, Applicant respectfully requests that future Office Action contain a detailed explanation of why the Examiner believes one of ordinary skill in the art would believe it obvious to combine the applied references. This explanation should include citations to any prior art that discloses known problems with the system and methods of Wigren, evidence that it was known in the art that technology from the non-analogous fields of Bauman and Ko could be applied to cell phone technology, and/or the alleged benefits that one of ordinary skill in the art would expect to be reaped from the asserted combinations.

Applicant also respectfully requests that the next Office Action be non-final. In the previous series of rejections Applicant repeatedly argued that the Office Action provided no justification for combining the applied references beyond the incorrect assertion that they were from "related fields of endeavor." The current Office Action found this argument persuasive, and withdrew the previous rejections. However, the current Office Action contains the same flaws. It again incorrectly asserts that the applied references are from the same field of endeavor and provides no further justification for combining the references. Such practice is impermissible hindsight.

Furthermore, the July 15 Request for Reconsideration explicitly requested that the Examiner provide such justification or rationale for his combinations of references. Applicant believes the continued failure of the Office Action to provide these explanations in both the current and previous Office Actions is unjustifiably delaying prosecution.

Applicant would appreciate the opportunity to address an Office Action containing a valid prima facie rejection, with the required supporting evidence, prior to the current rejection being finalized.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Moshe K. Wilensky
Registration No. 56,263

JAO:MKW/jfb

Date: January 16, 2009

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--